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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,248	10/19/2000	Mitsuteru Kataoka	2000 1450A	5018

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EXAMINER

EDELMAN, BRADLEY E

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/691,248

Applicant(s)

KATAOKA, MITSUTERU

Examiner

Bradley Edelman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This Office action is in response to Applicant's amendments and request for reconsideration filed on October 28, 2003. All of the original claims have been canceled (claims 1-14). Claims 15-37 are new claims and are presented for further examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 15-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In considering claim 15, the preamble on lines 1-3 of the claim is confusing. Due to the grammatical structure of the preamble, it is difficult to determine what the particular prepositional phrases refer to (i.e. it is not clear whether the phrase "for presenting the service" refers to the "system," the "service," the "content," or the "user interface," or whether the phrase "stored in said system" refers to the "user interface," the "service," or the "content").

In further considering claim 15, the phrase "so as to realize the user interface" on lines 5-6 of the claim is unclear. The verb "realize" is ambiguous as it is used in the claim. The verb can be interpreted in many ways, and an adequate interpretation is not given in the claim language (for instance, the term could mean "recognize," but could

also mean “implement,” or “use”). Thus the use of the term renders the claim ambiguous.

Claims 16-21 depend from claim 15 and are thus rejected for the same reasons.

In considering claim 22, the preamble on lines 1-3 and the limitation on lines 5-6 of the claim present the same ambiguities as claim 15 regarding the grammatical structure of the preamble and the use of the word “realizing.” In addition, it is unclear from lines 5-6 of the claim whether the phrase “as the content in its entirety or as part of the content” modifies the term “control content” or the term “user interface.”

Claims 23-28 depend from claim 22 and are thus rejected for the same reasons.

In considering claim 29, the preamble on lines 1-3 and the limitation on lines 5-6 of the claim present the same ambiguities as claim 15 regarding the grammatical structure of the preamble and the use of the word “realizing.”

Claims 30-37 depend from claim 29, and are thus rejected for the same reasons.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Note: Examiner has interpreted the claims in view of the specification.

a. Note that the claims mention transmitting a "user interface" and supplying a "user interface." This language does not mean that a user interface program, such as Netscape browser or other type of browser, is transmitted. Instead, when interpreted in view of the specification, the "user interface" transmitted is actually browser *content*.

See pages 16-22, describing the rendering, storage, and transmission of browser content.

b. Note that the claims mention a "service." This "service" is not defined in the claims. The specification describes a service as a "news" service or a "car guide" service. See p. 20, lines 16-21. Thus, the term "service" in the claims is interpreted to mean any content-specific web information (such as news) sent as a package.

To emphasize how these interpretations are applied to the claim language, for example, the "user interface unique to a service composed of content stored in said system for presenting the service" claimed in claim 15 is interpreted as a unique web page stored in a storage system.

c. Note that meaning of the word "realize" in the phrase "so as to realize the user interface" is not clearly defined in either the claims or the specification. Thus, the phrase is interpreted here to mean "to effect the user interface."

d. The "control content" described in the claims is interpreted as meaning "browser content," as described on page 18, lines 9-11 of the specification. "The browser content is *control code* executable under a program code execution environment provided by

the receiving apparatus.” Emphasis added. Interpreted as such, the “control content” may be portions of HTML code, JAVA code, or any other information that renders browser content.

e. The term “pitch” as used in the claims is interpreted to mean “send.” See p. 16, lines 14-15, “the content body pitcher 114 sends, or pitches, the provided content body...” Thus the term “pitcher” is interpreted to mean “sending means.”

f. The terms “service property information” and “properties of the service” are interpreted as relating to information that connotes any “properties” associated with the specific web pages that constitute the “service.”

2. Claims 15-18, 21-25, 28-32, and 35-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Durham (U.S. Patent No. 6,330,566).

In considering claim 15, as interpreted as described above, Durham discloses a storage-based broadcasting system (i.e. a World Wide Web server, col. 6, lines 55-58) that supplies unique web pages stored in a storage system, comprising:

Transmission means for transmitting browser content (which includes regular content, such as text, and “control content” such as HTML tags), the browser content used to execute the user interface (“the user interface (e.g., a web page) is presented to the client,” col. 10, lines 35-36)), wherein the unique web page is transmitted by the transmission means and received by said receiving means. See col. 9, line 53 – col. 10, line 11, describing that the server creates a web page to be transmitted to the client. Note that the limitations of “transmitting a control content as the content in its entirety or as part of the content” and “receiving at least part of the content” do not further limit the

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claim, since the control content must necessarily constitute at least some part of the overall content.

In considering claim 16, as interpreted as described above, Durham further discloses that the control content is browser content for the content stored in the system (i.e. web page information for specific user properties regarding layout; col. 10, lines 17-33).

In considering claim 17, as interpreted as described above, Durham further discloses that the transmission means comprises:

Content sending means for sending the content including the control content (inherent in a server that sends web page information to a client);

Service property information transmitting means for transmitting property information for indicating properties of the service (col. 10, lines 17-46, wherein user profile information indicates how to display a particular service, such as news information);

Wherein the receiving means receives the transmitted property information and determines, based on the content and the service property information, the control content from among the received content (i.e. the client receives the news content along with the display information and necessarily determines the two contents to display the information to the user; col. 10, lines 17-59).

In considering claim 18, Durham further discloses the content sending means adds to the content a content header for defining the content (inherent in order to send the content from the client to the server), and the receiving content uses the header to determine the control content from the rest of the received content (also inherent, since the client must read the header to process the information).

In considering claim 21, Durham further discloses that the content sending means comprises content ID space management means for sending information for defining a part of an ID space of the content, and the receiving means comprises designation means for designating the control content based on a content ID included in the defined part of the ID space (col. 10, lines 13-46; Fig. 4, wherein the cookie contains appropriate ID information to be used by both the sender and the receiver to define the layout and presentation of web information to the client).

In considering claim 22, claim 22 presents a method for performing the same steps described in claim 15. Therefore, claim 22 is rejected for the same reasons stated with regard to claim 15.

In considering claim 23, claim 23 presents a method for performing the same step described in claim 16. Therefore, claim 23 is rejected for the same reasons stated with regard to claim 16.

In considering claim 24, claim 24 presents a method for performing the same steps described in claim 17. Therefore, claim 24 is rejected for the same reasons stated with regard to claim 17.

In considering claim 25, claim 25 presents a method for performing the same steps described in claim 18. Therefore, claim 25 is rejected for the same reasons stated with regard to claim 18.

In considering claim 28, claim 28 presents a method for performing the same steps described in claim 21. Therefore, claim 28 is rejected for the same reasons stated with regard to claim 21.

In considering claim 29-32 and 35, claim 29 presents the same limitations as claim 15, and is thus rejected for the same reasons. Note that claim 29 uses terminology such as "a transmission unit operable to transmit a control content..." whereas claim 15 uses terminology such as "transmission means for transmitting a control content..." Thus, the only difference between these two claims is a matter of semantics. Both claims use a prescribed means to perform the same functions, and are thus rejected for the same reasons. This same methodology appears in claims 30-35 (which parallel claims 16-21). Thus, claims 30-32 and 35 are rejected for the same reasons as claims 16-18 and 21, respectively.

In considering claim 36, Durham further discloses a delivery unit to receive the content by the transmission unit and to transmit the content to the receiving unit (i.e. the network inherently includes intermediate devices that receive the server content and transmit it along a route to the receiving unit).

In considering claim 37, Durham further discloses that the content is transmitted as a digital bit stream to the delivery unit, which transmits the content as a digital bit stream to the receiving unit (i.e. messages sent across the Internet are inherently sent as digital bit streams).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 19-20, 26-27, and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durham, in view of Herz et al. (U.S. Patent No. 5,835,087, hereinafter "Herz").

In considering claims 19, 26, and 33 (which describe a system and method for performing the same steps), although the system taught by Durham discloses substantial features of the claimed invention, it fails to disclose the use of public keys

and electronic signatures in conjunction with the control content, as claimed.

Nonetheless, the use of public keys and electronic signatures in combination with control content, in systems that supply customized news and other information to users across the Internet, is well known, as evidenced by Herz (see Abstract and cols. 37-40, describing a detailed security system for controlling access to server information in a user-customized web page system). Thus, given the teaching of Herz, a person having ordinary skill in the art would have readily recognized the desirability and advantages of using a public key and electronic signatures with the system taught by Durham, so that users can maintain their own profiles without the threat of others hacking into the system and maliciously stealing user information or changing user settings. Therefore, it would have been obvious to include the claimed public key and electronic signature features, as taught by Herz, in the system taught by Durham.

In considering claims 20, 27, and 34, Herz further discloses that the key used for authentication of the electronic signature is unique to the service (Abstract, cols. 37-40, wherein the signature and public key are unique to a user's target profile).

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is (703) 306-3041. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on (703) 305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

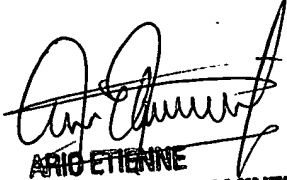
For all correspondences: (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

BE
January 25, 2004


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